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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,741	10/30/2003	Mei-Chiao Wu	11702-003006	9062

26161 7590 06/10/2005

FISH & RICHARDSON PC
225 FRANKLIN ST
BOSTON, MA 02110

EXAMINER

LILLING, HERBERT J

ART UNIT	PAPER NUMBER
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1651

DATE MAILED: 06/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/697,741

Applicant(s)

WU ET AL.

Examiner

HERBERT J. LILLING

Art Unit

1651

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03-03-2004 and 10-30-2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 33-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 33-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10-30-2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3-3-04</u> | 6) <input type="checkbox"/> Other: _____ |

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1. Receipt is acknowledged of the preliminary amendment filed October 30, 2003 and the prior art information disclosure statement filed March 03, 2004.

2. Claims 33-35 are pending in this application.

Claims 1-32 and 36-40 have been cancelled.

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 33-35 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while there is a possibility that the product by processes of the examples in the instant specification may be patentable, but the instant specification does not reasonably provide enablement for the instantly claimed product claims which requires a more restrictive standard than the processes allowed in the parent application. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and practice the invention commensurate in scope with these claims.

Applicant is **required to submit the structure of the products per se** in the claimed pharmaceutical composition having **"fungal molecules having molecular weights of no more than about 10kDa"**. There is no way to do a proper search and examination for the claimed subject matter drawn to these unknown products.

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Claims 33-35 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for fraction(s) as noted by the specification examples, does not reasonably provide enablement for the claimed subject matter without specificity of the process conditions to obtain the pharmacologically active fraction compositions. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and practice the invention commensurate in scope with these claims.

The language of the claims must make it clear what subject matter the claims encompass to adequately delineate their "metes and bounds". The courts have also indicated that before claimed subject matter can properly be compared to the prior art, it is essential to know what the claims do in fact cover. See, e.g., the following decisions: In re Steele, 305 F 2d. 859, 134 USPQ 292 (CCPA 1962); In re Moore 439 F 2d. 1232, 169 USPQ 236 (CCPA 1969); In re Merat, 519 F 2d. 1390, 186 USPQ 471 (CCPA 1975).

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 33-35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims are rendered vague and indefinite by the claimed processes because the processes do not adequately delineate its metes and bounds. The active compositions are products-by-process defined by the processes of its preparation but the claims lack sufficient information or limitations to define the composition that is isolated. Such products-by-processes claims are intended to define products, which are otherwise difficult to define and/or distinguish from the prior art except, by the process of making. Since any given biological source contains a multiple of possible active fractions as indicate, each with its own particular properties, the nature of the resulting A fraction will depend on the conditions to obtain the fractions. Applicant will be required to submit a sufficient number of properties for the claimed "active composition(s)" or "active fraction(s)" e.g., the specific molecular weight of the fraction, spectra properties, and or/and the specific separation processes. Accordingly, without the recitation of all these critical limitations as set forth above, the claims do not adequately define the instant invention.

6. As noted above, a proper search and examination cannot be properly made unless Applicant provides the necessary information as to the structure of the each and every component in the claimed pharmacologically active composition drawn to unknown molecules.

7. **No claim is allowed.**

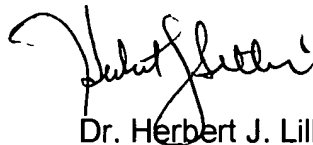
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8. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Examiner Lilling whose telephone number is 571-272-0918 and Fax Number is (703) 872-9306** or SPE Michael Wityshyn whose telephone number is 571-272-0926. Examiner can be reached Monday-Thursday from about 5:30 A.M. to about 3:00 P.M. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Information regarding the status of an application may be obtained from the Patent Application information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

H.J.Lilling: HJL
(571) 272-0918
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June 8, 2005



Dr. Herbert J. Lilling
Primary Examiner
Group 1600 Art Unit 1651